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Remarks

Thorough examination by the Examiner is noted and appreciated.

The claims have been amended.

No new matter has been added.

Support for the amended and new claims is found in the previously and originally presented claims, the Figures (including Figures 1, 1A, and 2) and the Specification.

Shift to non-elected Process

Examiner has previously examined the process claims (see Office actions of 1/23/2006, 11/16/2006, 4/10/2007, and 10/31/2007) and then subsequently required restriction with respect to product and process claims (see Restriction requirement of 3/20/2008 where Examiner required restriction between apparatus/product and process claims. After electing apparatus/product claims, Examiner then examined the elected

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claims as composition claims (office actions of 5/20/2008; 9/08/2008; note that Applicants representative mistakenly agreed that the claims were composition claims in a tel. conv. on or about 8/08/2008). After Examiner indicated amendments to the claims were required to treat the claims as product/apparatus claims in the office action of 12/04/2008 (see page 6), and declaring that an 'electrolyte bath' was a composition (see page 25), Applicants amended the claims to conform to amendment suggestions by Examiner in order to have the claims treated as product/apparatus claims. The Examiner in the latest office action has now made clear that she will not give patentable weight to an important aspect of the invention as a product/apparatus claim i.e., the arrangement of the suspended wetting layer within an electrolyte bath/apparatus, since Examiner argues it merely material worked on by an apparatus and cites MPEP 2115 or intended use of the apparatus under MPEP 2114.

Examiner is therefore respectfully requested to waive election and permit shift on the grounds that such shift will reduce additional work and expense by both the Applicants and the USPTO and will simplify the issues.

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Alternatively, Examiner has held that the invention is in the process rather than the product by her refusal to give patentable weight to the important aspect of Applicants invention i.e., the arrangement of the suspended wetting layer within an electrolyte bath/apparatus. Therefore, the shift to a process appears to be a permissible shift under USPTO MPEP guidelines.

#### **819.01 Office May Waive Election and Permit Shift**

While applicant, as a matter of right, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues. *Ex parte Heritage*, Pat. No. 2,375,414 decided January 26, 1944. If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned. *Meden v. Curtis*, 1905 C.D.272, 117 O.G. 1795 (Comm'r Pat. 1905).

#### **820 Not an Election; Permissible Shift**

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not shift: *Ex parte Trevette*, 1901 C.D. 170, 97 O.G. 1173 (Comm'r Pat. 1901).

Where a product is elected, there is no shift where examiner holds invention to be in the process. *Ex parte Grier*, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923).

#### **Claim Rejections under 35 USC 102/103**

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1. Claims 2 and 5-7 stand rejected under 35 USC Section 102(e) as anticipated by, or in the alternative under 35 USC Section 103(a) as obvious over, Bokisa (US 6,676,823).

Examiner asserts that all claim limitations outside of an electrochemical plaiting system and electrolyte bath container comprising an anode are "expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim (MPEP 2115)". ). Examiner also characterizes the claim limitations as intended use citing MPEP 2114.

Bokisa nowhere disclose the instantly claimed process.

2. Claims 9, 12-13 and 23-24 stand rejected under 35 USC Section 102(e) as anticipated by, or in the alternative under 35 USC Section 103(a) as obvious over, Bokisa (US 6,676,823).

The comments made above with respect to Bokissa are reiterated.

3. Claims 9, 12-13 and 23-24 stand rejected under 35 USC

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Section 102(e) as anticipated by, or in the alternative under 35 USC Section 103(a) as obvious over, Motoki et al. (US 6,911,138).

Examiner asserts that all claim limitations outside of an electrochemical plating system comprising an anode and electrolyte bath container are "expressions relating the apparatus to contents thereof during an intended operation are of not significance in determining patentability of the apparatus claim (MPEP 2115)". Examiner also characterizes the claim limitations as intended use citing MPEP 2114.

Motoki et al. nowhere disclose the instantly claimed process.

4. Claims 1-2,4-7, and 21-22 stand rejected under 35 USC Section 102(a) or (b) as anticipated by, or in the alternative under 35 USC Section 103(a) as obvious over, Applicants Admitted prior art (AAPA) (specification, page 4, [006]).

Examiner asserts that all claim limitations outside of an electrochemical plating system comprising an anode and electrolyte bath container are "expressions relating the apparatus to contents thereof during an intended operation are of

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not significance in determining patentability of the apparatus claim (MPEP 2115)". Examiner also characterizes the claim limitations as intended use citing MPEP 2114. Thus, Examiner has held that Applicants invention lies in the process.

Applicants alleged admitted prior art nowhere discloses the instantly claimed process.

5. Claims 9, 12-13 and 23-24 stand rejected under 35 USC Section 102(a) or (b) as anticipated by, or in the alternative under 35 USC Section 103(a) as obvious over, Applicants Admitted prior art (AAPA) (specification, page 4, [006]).

Examiner asserts that all claim limitations outside of an electrochemical plating system comprising an anode and electrolyte bath container are "expressions relating the apparatus to contents thereof during an intended operation are of not significance in determining patentability of the apparatus claim (MPEP 2115)". Examiner also characterizes the claim limitations as intended use citing MPEP 2114.

Applicants alleged admitted prior art nowhere discloses the instantly claimed process.

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Conclusion

By refusing to give patentable weight to important core aspects of applicants claims, Examiner has held that the invention lies in the process as between the restricted product and process claims and therefore the USPTO should allow a shift of Applicants claims to process claims either on the grounds it will reduce work and expense or that it is a permissible shift.

Applicants have amended their claims.

Applicants respectfully request favorable reconsideration of their claims and submit that Applicants Claims are now in condition for allowance. Such favorable action by the Examiner at an early date is respectfully solicited.

In the event that the present invention as claimed is not in a condition for allowance for any other reasons, the Examiner is respectfully invited to call the Applicants representative at his Bloomfield Hills, Michigan office at (248) 540-4040 such that necessary action may be taken to place the application in a condition for allowance.

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Respectfully submitted,

  
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